

Section II. (REMARKS)

The claims pending herein are 1, 2, 4-7, 10, 14, 15, 17-21, 24-31, 33-36, 43-50, and 53-59.

Cancelled Claims and Right to File Continuation or Divisional Applications Relating to said Subject Matter

Claims 8, 9, 11-13, 22, 23, 37, 38, 40-42, 51 and 52 have been cancelled herein without prejudice. Applicants hereby reserve the right to file continuation or divisional applications claiming the cancelled subject matter.

Amendment to Claims 10 and 39

Claims 10 and 39 have been amended to remove the previously excised "ACC" terminology so as to be consistent with the terms used in allowed claims 1 and 24 which they depend from, respectively. No new matter has been added herein.

Allowable Subject Matter

In the April 19, 2007 Office Action, the Examiner allowed claims 1, 2, 5, 6, 10, 14, 15, 17-21, 24-31, 33, 43-50, 53-57, 59, and claims 7 and 36 formula G only. Applicants acknowledge same.

It is noted that the Examiner did not indicate the disposition of claims 4, 34, 35 and 58.² Notably, claims 4 and 58 depend directly from allowed claim 1 and claims 34 and 35 depend directly from allowed claim 24.

Notably, the Examiner only allowed species G of claims 7 and 36. Applicants do not agree with this limited disposition and traverse same.

As recited in MPEP §808.01(a):

"In all applications where a generic claim is found allowable, the application should be treated as indicated in MPEP § 809 and §

² Also claim 52, which depends from non-elected and hence cancelled subject matter, and has been cancelled herein without prejudice.

821.04(a).” (emphasis added)

MPEP §809 recites:

“The most common types of linking claims which, if allowable, act to prevent restriction between inventions that can otherwise be shown to be divisible, are

(A) genus claims linking species claims; and

(B) subcombination claims linking plural combinations.

* * *

When all claims directed to the elected invention are allowable, should any linking claim be allowable, the restriction requirement between the linked inventions must be withdrawn. Any claim(s) directed to the nonelected invention(s), previously withdrawn from consideration, which depends from or requires all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability.” (emphasis added)

It is unclear why the Examiner has limited the allowance of the species claims to just Formulation G. Formulations A-F and H-C² also include the limitations of allowed claim 1, specifically a quaternary base, at least one alkali or alkaline earth base, and at least one additional component selected from the group consisting of a chelator, an oxirane species, and combinations thereof, wherein said chelator comprises a species selected from the group consisting of: 1-amino-1,2,4-triazole; 1-amino-1,2,3-triazole; 1-amino-5-methyl-1,2,3-triazole; 3-amino-1,2,4-triazole; 3-mercapto-1,2,4-triazole; 3-isopropyl-1,2,4-triazole; naphthotriazole; 2-mercaptobenzimidazole; 2-mercaptobenzothiazole; 5-aminotetrazole; 5-amino-1,3,4-thiadiazole-2-thiol; 2,4-diamino-6-methyl-1,3,5-triazine; thiazole; triazine; methyltetrazole; 1,3-dimethyl-2-imidazolidinone; 1,5-pentamethylenetetrazole; 1-phenyl-5-mercaptotetrazole; diaminomethyltriazine; mercaptobenzothiazole; imidazoline thione; 4-methyl-4H-1,2,4-triazole-3-thiol; 5-amino-1,3,4-thiadiazole-2-thiol; benzothiazole; tritoyl phosphate; indiazole; adenine; thioglycerol; salicylamide; iminodiacetic acid; benzoguanamine; melamine; thiocyanuric acid; anthranilic acid; 3-mercaptopropanol; and combinations thereof. According to the MPEP, the Examiner MUST rejoin and examine Formulations A-F and H-C².

Notably, if any of the species A-F and H-C² were not novel or non-obvious, the Examiner would have already cited the prior art disclosing these formulations (with the exact amount of each

component) against applicants' generic claim 1 during the course of the prosecution. The fact that claim 1 was found allowable in view of the prior art impliedly means that species A-F and H-C² are also allowable in view of the prior art.

Above and beyond the fact that the MPEP recites that they MUST be rejoined, the alternative is that applicants would have to file a continuation application in order to obtain allowance of said species. Assuming that applicants have the same Examiner, and the Examiner only allows one species at a time, applicants would be forced to file multiple continuation applications. This is not in the best interest of applicants nor the overworked Examiner's at the USPTO.

Applicants appreciate the need to complete prosecution of the presently pending case, however, if the Examiner does not agree that species A-F and H-C² MUST be rejoined, pursuant to the MPEP and the Rules, an interview will be requested between applicants undersigned representative and the Examiner and the Examiner's supervisor, Cynthia Kelly.

The Invention of Group I

According to the Examiner, the Group I invention claims a composition comprising:

- “(i) a quaternary base,
- (ii) alkali or alkaline earth base,
- (iii) an oxirane species and
- (iiii) a chelator.” (see the April 19, 2007 Office Action, page 2, lines 9-12)

In actuality, the Group I invention, as recited broadly in claim 1, is a composition comprising:

- “(i) a quaternary base,
- (ii) at least one alkali or alkaline earth base,
- (iii) at least one additional component selected from the group consisting of a chelator, an oxirane species, and combinations thereof.”³

³ wherein said chelator comprises a species selected from the group consisting of: 1-amino-1,2,4-triazole; 1-amino-1,2,3-triazole; 1-amino-5-methyl-1,2,3-triazole; 3-amino-1,2,4-triazole; 3-mercapto-1,2,4-triazole; 3-

In other words, the composition of claim 1 may be any of the following combinations: (i) a quaternary base, at least one alkali or alkaline earth base, and an oxirane species; (ii) a quaternary base, at least one alkali or alkaline earth base, and a chelator³; or (iii) a quaternary base, at least one alkali or alkaline earth base, an oxirane species, and a chelator³.

Applicants request that the Examiner acknowledge the correct recitation of components in claim 1 and that the composition recited by him in the April 19, 2007 Office Action was only partially correct (i.e., there are two other possible combination of components in claim 1).

Conclusion

Claims 1, 2, 4-7, 10, 14, 15, 17-21, 24-31, 33-36, 43-50, and 53-59 are in form and condition for allowance. If any additional issues remain, the Examiner is requested to contact the undersigned attorney at (919) 286-8090 to discuss same. Authorization is hereby given to charge any deficiency in applicable fees for this response to Deposit Account Number 13-4365 of Moore & Van Allen PLLC.

Respectfully submitted,

MOORE & VAN ALLEN PLLC

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isopropyl-1,2,4-triazole; naphthotriazole; 2-mercaptopbenzoimidazole; 2-mercaptopbenzothiazole; 5-aminotetrazole; 5-amino-1,3,4-thiadiazole-2-thiol; 2,4-diamino-6-methyl-1,3,5-triazine; thiazole; triazine; methyltetrazole; 1,3-dimethyl-2-imidazolidinone; 1,5-pentamethylenetetrazole; 1-phenyl-5-mercaptopotetrazole; diaminomethyltriazine; mercaptobenzothiazole; imidazoline thione; 4-methyl-4H-1,2,4-triazole-3-thiol; 5-amino-1,3,4-thiadiazole-2-thiol; benzothiazole; tritolyl phosphate; indiazole; adenine; thioglycerol; salicylamide; iminodiacetic acid; benzoguanamine; melamine; thiocyanuric acid; anthranilic is thereof.